

Attorney Docket No.: DEX-0201
Inventors: Yang et al.
Serial No.: 09/817,607
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REMARKS

Claims 1, 3-6 and 9 are pending in the instant application. Claims 1, 3-6 and 9 have been rejected. Claim 1 has been amended. Support for amendments to claim 1 is provided in the specification at pages 56-58. Thus, no new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims 1, 3-6 and 9 under 35 U.S.C. § 112, first paragraph - Written Description

Claims 1, 3-6 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner has acknowledged that the written description sets forth SEQ ID NO:8, a colon specific gene. However, the Examiner suggests that the written description does not set forth a nucleic acid sequence having at least 95% identity with SEQ ID NO:8.

Applicants respectfully traverse this rejection since the

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application as filed clearly taught at page 18 polynucleotides of 95% identity to SEQ ID NO:8, thus establishing Applicants to be in possession of this invention upon filing of the application. Detailed methods or exemplary sequences with 95% identity to SEQ ID NO:8 need not be provided in the instant specification since these can be determined routinely by those of skill in the art by conventional means based upon the teachings of the instant application. See MPEP § 2163, Part A.

However, in an earnest effort to advance the specification of this case, Applicants have amended part (b) of claim 1 to clarify that the nucleic acid sequence is overexpressed in colon cancer tissue. Support for this amendment is provided in the specification at pages 56-58. Thus, no new matter is added by this amendment.

Applicants believe that the pending claims as amended, which are clearly supported by the specification, set forth definitive structural features of the claimed polynucleotides so that one of skill in the art can predictably identify the encompassed molecules as being identical to those now claimed. Further, the claims as amended describe distinguishing identifying characteristics sufficient to show that applicant was in possession of the claimed invention. See MPEP § 2163.02. Thus,

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the claims as amended meet the written description requirements of 35 U.S.C. § 112, first paragraph.

Withdrawal of this rejection is therefore respectfully requested.

II. Rejection of Claims 1, 3-6 and 9 under 35 U.S.C. § 112, first paragraph -Enablement

Claims 1, 3-6 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner has acknowledged the specification and Inventor Declaration to provide evidence of the diagnostic applicability of SEQ ID NO:8. However, the Examiner suggests that neither the specification nor Inventor Declaration provide support for use of polynucleotides with at least 95% identity to SEQ ID NO:8.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended part (b) of claim 1 to clarify that the nucleic acid sequences are overexpressed in colon cancer tissue. Support for this amendment is provided in

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the specification at pages 56-58. Thus, no new matter is added by this amendment.

Methods for identifying polynucleotide with 95% identity to SEQ ID NO:8 are well known and need not be described in detail in the instant specification. Further, methods for identifying nucleic acid sequences which are overexpressed in colon cancer tissue such as SEQ ID NO:8 are outlined in detail in the specification at pages 56-58. Accordingly, the instant specification provides sufficient guidance for one of skill in the art to make and use the invention as claimed without undue experimentation, thus meeting the enablement requirements as set forth in MPEP § 2164.01.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, for lack of enablement, is therefore respectfully requested.

III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending

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LICATA & TYRRELL

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claims is earnestly solicited.

Respectfully submitted,

Kathleen A. Tyrrell
Kathleen A. Tyrrell
Registration No. 38,350

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LICATA & TYRRELL P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515